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10/749,478

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J. Nelson Wright

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EXAMINER

KISH, JAMES M

ART UNIT

PAPER NUMBER

3737

NOTIFICATION DATE

DELIVERY MODE

02/11/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/749,478 | Applicant(s) WRIGHT ET AL. | |
| | Examiner JAMES KISH | Art Unit 3737 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 3, 2011 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 6-13 and 16 have been considered but are moot in view of the new ground(s) of rejection.

However, the Examiner will address the last paragraph on page 6 of the Applicant's response, as it relates to the 35 U.S.C. 112 rejections below. The Applicant states that the amendments to the claims are taught on page 15 of the specification. After reading page 15, the Examiner notes that - while this page discusses in clear and understandable detail that the resonant frequency may be matched via analysis by the receiver - nowhere on page 15 is there any mention of the excitation interval and/or observation interval being automatically adjusted (or adjustably programmable) in the receiver to match the resonant frequency of the marker (as is claimed in claims 6, 9 and 12). In fact, on page 17 of the specification, at lines 18-22 it states, "Additionally, the receiver 208 may be adapted to the ring time of the marker. Various marker designs

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may have varying ring times... Because of this, it may be advantageous to adjust the excitation pulse interval and the observation interval (emphasis added)." As such, the claim amendments to claims 6, 9 and 12 constitute new matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,977,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to "A system for locating a marker associated with a patient/subject." Both claims comprise an excitation source, at least one sensing coil and a receiver. Regarding the claim of Patent No. 6,997,504 comprising a plurality of

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sensing coils; it has been that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,977,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient/subject.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,977,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient/subject.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’ Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,977,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient/subject.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’ Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15

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USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,026,927. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Regarding the claim of Patent No. 7,026,927 comprising a plurality of sensing coils; it has been that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,026,927. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient.” Both claims comprise an excitation source, at least one sensing coil and a

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receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “Apparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,026,927. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are directed to “A system for locating a marker associated with a patient.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “Apparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,026,927. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because both claims are directed to “A system for locating a marker associated with a patient.” Both claims comprise an excitation source, at least one sensing coil and a receiver. Furthermore, both claims provide functional language and/or intended use that does not structurally limit the apparatus. Section 2114 of the MPEP states (with emphasis in the original), “‘Apparatus claims cover what a device *is*, not what a device *does*.’ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).” Therefore, these system claims provide for the same subject.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has amended claims 6 and 12 by removing “the characteristics” and replacing this with “a resonant frequency.” Furthermore, claim 9 has added “to match a resonant frequency of the marker.” The specification states that “the excitation interval or the observation interval can be adjusted to match the characteristics of the marker. Thus, the length of excitation

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interval or observation interval is programmable (or automated) in the receiver 208 in order to optimize the sensing system 100 (see lines 20-23 on page 13 of the originally filed specification)." Furthermore, on page 17, at lines 18-22, "Additionally, the receiver 208 may be adapted to the ring time of the marker. Various marker designs may have varying ring times... Because of this, it may be advantageous to adjust the excitation pulse interval and the observation interval." However, the new amendments state that the characteristic to be matched is the resonant frequency. The Examiner cannot find an instance in which "said excitation interval and/or observation interval can be automatically adjusted in said receiver to match *a resonant frequency* of said marker." The excitation interval and observation interval are intervals and therefore relate to a time period, rather than a particular frequency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dimmer (US Patent Pub. No. 2003/0122653) in view of Rodgers et al. (US Patent No. 6,362,737) - herein referred to as Rodgers. Dimmer discloses a system for excitation of a leadless miniature marker. The system includes a source (see paragraph 69 and Figure 3). "The pulsed source generator... is adjustable to generate a pulsed magnetic

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field having a waveform that contains energy at selected frequencies that substantially match the resonant frequency of the specifically tuned marker assembly (see paragraph 28 – i.e., an excitation source having a tunable frequency). “When the marker assembly is excited by the magnetic field, the signal element generates the response marker signal containing frequency components centered at the marker’s resonant frequency (see paragraph 28).” Dimmer includes a sensing array as seen in Figure 3 (see “Sensors mounted on reference frame” and numerals 16 and 26). The sensing coils provide an output which then passes through pre-amplifiers and analog-to-digital converters to the signal processing device, which contains at least one receiver, as is labeled by Dimmer (see “Signal Processing Device” of Figure 3). However, the Examiner notes that the entire signal processing device is being interpreted as the receiver, not just the rectangles labeled “Receiver” in Figure 3. In paragraph 28, Dimmer states “the pulsed source generator 18, in one embodiment, is adjustable to generate a pulsed magnetic field 20 having a waveform that contains energy at selected frequencies that substantially match the resonant frequency of the specifically tuned marker assembly 14.” However, Dimmer fails to explain how the generator is aware of the specific frequency needed. Rodgers teaches an object identification system with adaptive transceivers. “A monitor includes a first transmitter, a first receiver and a processor (see lines 3-4 of the Abstract).” “The processor performs a method for performing transceiver communication that includes the steps of: (a) transmitting from the first transmitter a first frequency for a first duration; (b) after lapse of the first duration, receiving via the first receiver a response signal from at least one of the

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resonant circuits; (c) determining a second frequency from the received response signal; and (d) performing transceiver communication using the second frequency (see lines 6-14 of the Abstract).” It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the specifics of a second frequency determination for communication, as taught by Rodgers, with the system of Dimmer in order to “establish communication with a single transceiver at a frequency better suited for ... conducting an interrogation protocol for identifying the transceiver... (see the last 6 lines of the Abstract).”

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES KISH whose telephone number is (571)272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Kish/
Examiner, Art Unit 3737